

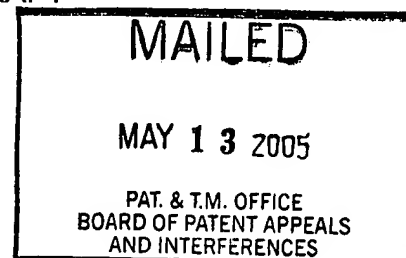
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex part MICHAEL L. EMENS & REINER KRAFT

Appeal No. 2005-0699
Application No. 09/583,516

ON BRIEF



Before GROSS, MACDONALD, and NAPPI, ***Administrative Patent Judges.***

MACDONALD, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-3, 5-23,
and 25-37. Claims 4 and 24 have been canceled.

Invention

Appellants' invention relates to a system, a program storage device, a
computer program and a method for targeting advertising based upon an
information repository search by a user, comprising associating an
advertisement with a result from the information repository search. This method
further comprises providing the advertisement on demand by the user. The
information repository may be associated with a server. The associating step of
this method further comprises: analyzing the search result to produce at least

one keyword; using the keyword to search for the associated advertisement within the repository; identifying the associated advertisement from the repository having a word that matches the keyword as related to the search result; and, correlating the associated advertisement with the search result.

Appellants' specification at page 3, lines 10-20.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of targeting at least one associated advertisement from an Internet search having access to an information repository by a user, comprising:

identifying at least one search result item from a search result of said Internet search by said user;

searching for said at least one associated advertisement within said repository using said at least one search result item;

identifying said at least one associated advertisement from said repository having at least one word that matches said at least one search result item; and

correlating said at least one associated advertisement with said at least one search result item.

References

The references relied on by the Examiner are as follows:

Skillen et al. (Skillen)

WO 98/36366

Aug. 20, 1998

Rejections At Issue

Claims 1-3, 5-12, 15-20, 22-23, and 25-29 stand rejected under 35 U.S.C. § 102 as being anticipated by Skillen.¹

Claims 13-14, 21, 30, and 37 stand rejected under 35 U.S.C. § 103 as being obvious over Skillen.

We also use our authority under 37 CFR § 41.50(b) to enter a new ground of rejection of claims 34-37. The basis for this is set forth in detail below.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.²

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-3, 5-12, 15-20, 22-29, and 31-36 under 35 U.S.C. § 102, and we reverse the Examiner's rejection of claims 13-14, 21, 30, and 37 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

¹ Claim 24 is listed as being rejected. However, claim 24 has been cancelled.

² Appellants filed an appeal brief on May 4, 2004. The Examiner mailed an Examiner's Answer on July 28, 2004.

Appellants have indicated that for purposes of this appeal, the claims stand or fall together in six groupings.³ See page 3 of the brief. However, Appellants have only presented specific arguments as to claims 1, 16, and 32. See pages 5, 7, and 10 of the brief. All other claim discussions merely refer back to the arguments directed to claims 1, 16, and 32. Therefore, Appellants have not fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in three groups, and we will treat:

Claim 1 as a representative claim of Group I (claims 1-3, 5-15, 22-23, and 25);

Claim 16 as a representative claim of Group II (claims 16-21, 26-31, and 35-37); and

Claim 32 as a representative claim of Group III (claims 32-34).

³ Claims 31 and 34 are not listed in any group, but are discussed in the arguments section of the brief.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejections of Claims 1-3, 5-12, 15, 22-23, and 25 Under 35 U.S.C. § 102 and Claims 13-14 Under 35 U.S.C. § 103 are proper?

It is our view, after consideration of the record before us, that the disclosure of Skillen does not fully meet the invention as recited in claims 1-3, 5-12, 15, 22-23, and 25. Accordingly, we reverse.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 13-14. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue at page 5 of the brief that Skillen does not teach three features of claim 1. As to the first two

features, we find that Skillen does indeed teach “identifying at least one search result item” at the last line of page 7, and “searching . . . using the at least one search result item” at lines 1-3 of page 8. However, as to the claimed “at least one word that matches”, we find nothing in Skillen that teaches that the “logical tree strategy” includes this third feature. While it might be argued that it would have been obvious in the extreme to include such a feature in the Skillen’s device, that is not the rejection before us.

Therefore, we will not sustain the Examiner’s rejections under 35 U.S.C. § 102 and § 103.

II. Whether the Rejections of Claims 16-20, 26-29, 31, and 35-36 Under 35 U.S.C. § 102 and Claims 21, 30, and 37 Under 35 U.S.C. § 103 are proper?

It is our view, after consideration of the record before us, that the disclosure of Skillen does not fully meet the invention as recited in claims 16-20, 26-29, 31, and 35-36. Accordingly, we reverse.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 21, 30, and 37. Accordingly, we reverse.

With respect to independent claim 16, Appellants argue at page 7 of the brief that Skillens does not teach “designating each of said search result items” and “providing a corresponding graphical user interface [(GUI)] for each of said

search result items.” We agree. We find that claim 16, as a whole, requires a system where each of a plurality of search result items has its own advertisement matched therewith and a GUI for each item, then when the user selects the GUI of a search result item an advertisement is retrieved. We find that although the process of Skillen shares some aspects of the claimed process, Skillen does not teach the process of claim 16. Rather, we find that the logical tree strategy process in Skillen only matches advertising with one search result item at a time and only after the user selects the GUI of the search result item.

Therefore, we will not sustain the Examiner’s rejections under 35 U.S.C. § 102 and § 103.

III. Whether the Rejections of Claims 32-34 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Skillen does not fully meet the invention as recited in claims 32-34. Accordingly, we reverse.

With respect to independent claim 32, Appellants argument at page 10 of the brief is essentially the same argument above with respect to claim 16. We reach the same result for the same reason.

Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 102.

IV. Rejection of Claims 34-37 Under 37 CFR § 41.50(b).

We make the following new grounds of rejection using our authority under 37 CFR § 41.50(b).

Claims 34-37 are rejected under 35 U.S.C. § 101, because the claimed invention is directed to non-statutory subject matter.

The claimed invention taken as a whole is directed to a mere computer program (a program listing), i.e., to only its description or expression. The claim is descriptive material per se and hence non-statutory. A computer program is merely a set of instructions capable of being executed by a computer; the computer program itself is not a process. A claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, is non-statutory functional descriptive material. See MPEP § 2106 IV. B. 1. (a).

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 102 of claims 1-3, 5-12, 15-20, 22-23, and 25-29; and we have not sustained the rejection under 35 U.S.C. § 103 of claims 13-14, 21, 30, and 37.

We have entered a new ground of rejection against claims 34-37 under 37 CFR § 41.50(b).

As indicated *supra*, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, by final rule notice, 69 Fed. Reg 49960, 50008 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21, 61 (September 7, 2004)). 37 CFR § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, ***WITHIN TWO MONTHS FROM THE DATE OF THE DECISION***, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .
- (2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record . . .

REVERSED; 37 CFR § 41.50(b)

Anita Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Allen B. MacDonald

ALLEN R. MACDONALD
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES


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